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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Confirmation No.: 6969
Del Soldato *et al.* Group Art Unit: Unknown
Application Serial No.: 10/522,986 Examiner: Unassigned
Filed: February 2, 2005 Attorney Docket No.: 026220-00061

For: Process for Preparing Nitrooxyalkyl Substituted Esters of Carboxylic Acids,
Intermediates Useful in Said Process and Preparation Thereof

SECOND RESPONSE TO DECISION ON PETITION UNDER 37 C.F.R. §1.47(a)

Mail Stop PCT

September 13, 2006

Assistant Commissioner for Patents
Attn: PCT Legal Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Decision on Petition, dated May 25, 2006, regarding the applicants' Petition under 37 C.F.R. § 1.47(a) filed September 15, 2005, and Renewed Petition under 37 C.F.R. § 1.47(a) filed June 6, 2006, in response to the Notification of Missing Requirements dated August 8, 2005, which requested an oath/declaration containing the signature of inventor Piero Del Soldato.

At this time, applicants enclose an oath/declaration executed by Piero Del Soldato, an inventor of the above-identified U.S. patent application. As such, the applicants respectfully submit that the requirements of 35 U.S.C. § 371 and 37 C.F.R. § 1.497 have been satisfied and that the previously filed Petitions and Decision have been rendered moot.

For at least the above reasons, the applicants respectfully request that the Office of PCT Legal Administration forward the file to the Office of Initial Patent Examination

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Inventor(s): Del Soldato *et al.*
Attorney Docket No.: 026220-00061

(OIPE) for further processing. Any further delay will cause irreparable harm to the invention. If any questions or issues remain, the Office of PCT Legal Administration is respectfully requested to contact the undersigned to help with their resolution.

If this response is not timely filed, the applicants hereby petition for an appropriate extension of time. The Commissioner is authorized to charge any additional fees or credit any over-payments to Deposit Account No. 01-2300, referencing Attorney Docket No. 026220-00061.

Respectfully submitted,

ARENT FOX PLLC



Amy E.L. Schoenhard

Registration No.: 46,512

Customer No.: **004372**
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Telephone No.: 202-857-6000
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Enclosure: Oath/Declaration executed by Piero Del Soldato



Docket No. 026220-00061

ARENT FOX PLLC

Declaration and Power of Attorney for U.S. Patent Application

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

(Insert Title) PROCESS FOR PREPARING NITROOXYALKYL SUBSTITUTED ESTERS OF CARBOXYLIC ACIDS, INTERMEDIATES USEFUL IN SAID PROCESS AND PREPARATION THEREOF

the specification of which is attached hereto unless the following box is checked:

☒ was filed on August 6, 2003 As PCT International Application
Number PCT/EP2003/008700 and was amended on _____
And/or was filed on _____ As United States Application
Number _____ and was amended on _____

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claim(s), as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. §1.56.

I hereby claim foreign priority benefits under 35 U.S.C. §119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below any foreign application for patent or inventor's certificate or PCT International Application having a filing date before that of the application(s) for which priority is claimed:

(List prior foreign applications)	<u>MI2002A001861</u> (Number)	<u>Italy</u> (Country)	<u>29/08/2002</u> (Day/Month/Year Filed)	Priority Claimed <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No
	_____ (Number)	_____ (Country)	_____ (Day/Month/Year Filed)	<input type="checkbox"/> Yes <input type="checkbox"/> No
	_____ (Number)	_____ (Country)	_____ (Day/Month/Year Filed)	<input type="checkbox"/> Yes <input type="checkbox"/> No

I hereby claim the benefit under 35 U.S.C. §119(e) of any United States provisional application(s) listed below.

_____ (Application Number)	_____ (Filing Date)
_____ (Application Number)	_____ (Filing Date)

☐ See attached list for additional prior foreign or provisional applications.

I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s) or §365(c) of any PCT International application(s) designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior application(s) (U.S. or PCT) in the manner provided by the first paragraph of 35, U.S.C. §112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. §1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

(List prior U.S. Applications or PCT International applications designating the U.S.)

_____ (Application Serial No.)	_____ (Filing Date)	_____ (Status) (patented, pending, abandoned)
_____ (Application Serial No.)	_____ (Filing Date)	_____ (Status) (patented, pending, abandoned)

Power of Attorney: I hereby appoint the firm of Arent Fox, Customer Number 004372, including at least the following registered practitioners, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith as follows:

Berman, Richard J., Reg. No. 39,107
Cherdak, Erik, Reg. No. 39,936
Chesser, Wilburn, Reg. No. 41,668

Marmelstein, Charles M., Reg. No. 25,895
Murphy, Christopher, Reg. No. 39,786
Oram, George E., Jr., Reg. No. 27,931

and other registered practitioners associated with Customer Number 004372

Please direct all communications to the following address:

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The undersigned hereby authorizes the U.S. attorneys named herein to accept and follow instructions from the undersigned's assignee, if any, and/or, if the undersigned is not a resident of the United States, the undersigned's domestic attorney, patent attorney or patent agent, as to any action to be taken in the Patent and Trademark Office regarding this application without direct communication between the U.S. attorneys and the undersigned. In the event of a change in the person(s) from whom instructions may be taken, the U.S. attorneys named herein will be so notified by the undersigned.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or first inventor Piero DEL SOLDATO

Inventor's
signature

Piero del Soldato

September 7, 2006

Date

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18/02/2005

Date

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Full name of third inventor Francesca BENEDINI

Inventor's
signature

Francesca Benedini

18/02/2005

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Full name of fourth inventor

Inventor's
signature

Date

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Full name of fifth inventor

Inventor's
signature

Date

Residence

Citizenship

Post Office Address

Full name of sixth inventor

Inventor's
signature

Date

Residence

Citizenship

Post Office Address